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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/604,763 | 06/26/2000 | Tsuyoshi Katayama | 2185-0452P-SP | 3604 |

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| EXAMINER |
|---|
| WELLS, LAUREN Q |

| ART UNIT | PAPER NUMBER |
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| 1617 | 19 |

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/604,763 | Applicant(s) KATAYAMA ET AL. | |
|---|---|---|---|
| | Examiner Lauren Q Wells | Art Unit 1617 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *17-29 and 33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17-29 and 33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

## DETAILED ACTION

Claims 17-29 and 33 are pending. The Amendment filed 4/9/03, Paper No. 18, amended claims 17 and 33.

### *Response to Applicant's Arguments/Amendment*

The Applicant's arguments filed 4/9/03 (Paper No. 18) to the rejection of claims 17-29 and 33 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Amendment filed 4/9/03 (Paper No. 18), wherein claims 17 and 33 are amended, is sufficient to overcome the 35 USC 112 rejection in the previous Office Action.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-20, 22-29, and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (5,795,978) in view of Akrongold (3,846,550).

The instant invention is directed to a cosmetic comprising a dimerdiol ester of a monocarboxylic acid having 10-32 carbon atoms and/or a dimerdiol ester of a dicarboxylic acid.

Ansmann et al. teach emulsifiers particularly suitable for the production of storable, high viscosity and sensorially light oil-in-water emulsions which are for use in cosmetic and/or pharmaceutical formulations. Suitable oils for said emulsions include esters of linear and/or branched fatty acids with polyhydric alcohols, for example dimmer diol or trimer diol, and/or

Guebert alcohols. Suitable oils are disclosed as comprising 5-99% of the non-aqueous components of the emulsions. Exemplified are oil-in-water creams with vitamin E. The reference fails to teach the number of carbon atoms the fatty acids comprise. See abstract; Col. 1, lines 10-15; Col. 4, lines 39-56.

Akrongold et al. teach a cosmetic skin powder containing urea, an oil phase and an inorganic pigment. Oils that may be used in the powder include acids and alcohols which may be saturated or unsaturated, straight or branched and comprising 5-52 carbons. Acids included for said oils are oleic, stearic, isostearic and dimer acids, and esters thereof. See abstract; Col. 1, lines 24-60.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Akrongold into the invention of Ansmann to obtain carboxylic acids or monocarboxylic acids of fatty acids having 4-34 carbon atoms because a) both references teaches esters of fatty acids as oils for use in skin care compositions; b) Ansmann teaches other fatty acid ester oils as comprising 6-20 carbon atoms; thus, given that Ansmann teaches other fatty acids ester oils as comprising 6-20 carbon atoms and given that Akrongold teaches that fatty acid esters can comprise 5-52 carbon atoms, one of skill in the art would have been motivated to teach the "esters of linear and/or branched fatty acids with polyhydric alcohols (for example dimer diol" of Ansmann, as comprising 5-52 carbon atoms.

Regarding the last 3 lines of claim 33, it is respectfully pointed out that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. in view of Akrongold as applied to claims 17-20, 22-29, and 33 above, and further in view of Bernhardt et al. (4,788,054).

Ansmann and Akrongold are applied as discussed above. The references lack rosin.

Bernhardt et al. teach coating compositions comprising cosmetic emulsifiers and thickeners or viscosity modifiers. Suitable thickeners include ester gums which are semi-synthetic reaction products of rosin and a polyhydric alcohol. See abstract; Col. 8, line 38-Col. 9, line 16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bernhardt into the invention of the combined references and obtain monocarboxylic acids comprising rosin or hydrogenated rosin because a) the combined references and Bernhardt all teach cosmetic emulsions comprising fatty acid esters as cosmetic oils; b) Bernhardt teaches that rosin esters increase the viscosity of emulsions, thereby thickening them; thus, since the combined references teach their emulsions in the forms of creams and lotions, one of skill in the art would be motivated to teach the fatty acids of the combined references as rosin because of the expectation of thickening their products.

***Response to Arguments***

Applicant argues, "Ansmann '978 merely mentions that esters of linear and/or branched fatty acids with polyhydric alcohols, such as "dimer diol" or "trimer diol" are suitable oils". This

argument is not persuasive. The Examiner respectfully points out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).

Applicant argues, "Applicants submit that 'dimer diol' and 'dimerdiol' and 'trimerdiol' and 'trimer diol' discussed at column 3, lines 14-17 and column 4, line 49 of Ansmann '978 are different compounds from 'dimerdiol' as used in the present invention". This argument is not persuasive. Applicant has provided no evidence that the dimer diol recited by Ansmann is distinct from the dimer diol as defined by the instant invention.

Regarding Applicant's arguments toward the "trimer diol", the Examiner respectfully points out that such arguments are moot, as the Examiner has not used the teaching of a "trimer diol" to reject any of the instant claims.

Applicant argues, "It appears, however, that dimer diol as used in Ansmann is represented by the formula HO-Ar-O-Ar-OH, wherein Ar is ethylene". This argument is not persuasive. The Examiner respectfully points out that Applicant has provided no basis for arriving at such a conclusion.

Applicant argues, "Ansmann '978 fails to disclose the specific compounds of esters of linear and/or branched fatty acids with polyhydric alcohols, such as esters of dimer diol or trimer diol". This argument is not persuasive. The Examiner respectfully directs Applicant to Col. 4,

lines 39-56 of Ansmann, which states, that the emulsifiers can be "esters of linear and/or branched fatty acids with polyhydric alcohols, wherein dimer diol is taught as a polyhydric alcohol.

Applicant argues, "since the disclosure of Akrongold '550 fails to disclose or suggest polyhydric alcohols, it also fails to teach or suggest to those of ordinary skill in the art the dimerdiol esters of the present invention". This argument is not persuasive. The Examiner respectfully points out that Akrongold was relied upon to teach carbon chain lengths of dimer acids.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding Bernhardt, Applicant argues, "these esters are also outside the scope of the esters of the present invention". This argument is not persuasive. The Examiner respectfully points out that Bernhardt was merely relied upon to teach rosin and the beneficial aspects of adding rosin to cosmetic compositions.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
May 26, 2003

SREENI PADMANABHAN
PRIMARY EXAMINER

6/1/05